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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,587	04/14/2000	JOHN A. DANE	EPRNT-101XX	2045
7590 Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			EXAMINER TODD, GREGORY G	
			ART UNIT 2457	PAPER NUMBER
			MAIL DATE 12/01/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/529,587

**Applicant(s)**

DANE ET AL.

**Examiner**

GREGORY G. TODD

**Art Unit**

2457

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5, 7, 8, 10, 14-17, 19, 20, 23-25, 27, 28 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 7, 8, 10, 14-17, 19, 20, 23-25, 27, 28 and 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to applicant's amendment filed 22 July 2008, of application filed, with the above serial number, on 14 April 2000 in which claims 32 and 34 have been amended. Claims 3-5, 7-8, 10, 14-17, 19-20, 23-25, 27-28 and 30-36 are pending in the application.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 3-5, 7-8, 10, 14-17, 19-20, 23-25, 27-28, and 30-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Garfinkle et al (hereinafter "Garfinkle", 6,017,157).

As per Claims 32, Garfinkle teaches a computer method for storing and saving electronic photographic images comprising:

providing access to a server having picture memory adapted to store said electronic photographic images obtained by a photographer at an event (at least col. 3:52-67; digital images from photographer), an event profile with respect to said event

having information relating to said event (at least col. 4:57-65; col. 5:59; eg. name), an ordering interface and a communication link for allowing communication over a public network (at least col. 5:10-26; ordering over www), said server providing access to said electronic photographic images stored in said picture memory by said photographer and customers of said photographer having correct access information (at least col. 8:49-55; 4:55-56; selective authorized access), said ordering interface further providing access to an image profiler only by said photographer and/or host of said event adapted to sequence and caption said stored electronic photographic images for display to said customers of said photographer (at least col. 5:10-29; col. 9:42-56; eg. photographer access to online proof sheet; editing);

said server adapted to transact remote payment information with respect to a financial institution for verifying payment of an order placed by said customers of said photographer through said ordering interface (at least col. 9:26-38); and

wherein said ordering interface is operable to be remotely accessed by said customer of said photographer over said public network using a browser for the purpose of ordering an image product with respect to said stored electronic photographic images (at least col. 5:10-29; browser ordering of visual prints).

As per Claim 33, Garfinkle teaches a method of remotely uploading, storing, reviewing, and editing electronic photographic images on behalf of a customer comprising:

using a digital camera for storing visual images therein (at least col. 3:52-55; digital camera);

transmitting said electronic photographic images stored on said camera to an order server (at least col. 3:55-67; transfer to image servers);  
creating an event profile having information relating to said event (at least col. 4:57-65; col. 5:59; eg. name),  
sequencing and captioning said electronic photographic images by said photographer and/or event host for display to customers of said photographer (at least col. 5:10-29; col. 9:42-56; eg. photographer access to online proof sheet; editing);  
storing said electronic photographic images on a memory at said order server for remote access by a remote customer of said photographer over a public network using a client browser (at least col. 5:10-67; Raid storing images for browser view over www);  
displaying selected electronic photographic images from said memory to said remote customer having correct access information over said public network in accordance with the sequence and captioning (at least col. 5:10-29);  
receiving an order from said remote customer enumerating a subset of said electronic photographic images (at least col. 7:43-52; number of visual prints to be ordered); and  
producing a hardcopy rendition of said subset of electronic photographic images (at least col. 7:43-52; visual prints).

Claim 34 does not add or define, in substance, any additional limitations over claims 32-33 and therefore is rejected for similar reasons.

As per Claims 3 and 23.

wherein said ordering interface access providing step further comprises providing access to a customer order selector adapted to enumerate and quantify a subset of said

electronic photographic images to be produced as said hardcopy renditions (at least col. 7:43-52; number of visual prints to be ordered).

As per Claims 4 and 24.

wherein said ordering interface access providing step further comprises providing access to a customer proofbook adapted to store a subset of said electronic photographic images, wherein said customer proofbook persists between said remote accesses by said customer (at least col. 5:10-29; online proof sheet).

As per Claims 5 and 25.

wherein said payment verifier access providing step enables transmitting payment corresponding to production of said hardcopy renditions in response to notification from said financial institution (at least col. 9:26-41; billing/credit card standard).

As per Claims 7 and 27.

wherein said image loader access providing step enables receiving said electronic photographic images from a non-volatile digital media (at least col. 5:36-64; eg. RAID).

As per Claims 8 and 28.

wherein said non-volatile digital media is selected from the group consisting of magnetic and optical formats (at least col. 5:36-64; eg. RAID).

As per Claim 10.

wherein said translating comprises scanning a visual image into a digital storage format (at least col. 3:4-20; scanning).

As per Claim 14.

wherein said displaying is in response to interactive selecting by said customer through said publicly accessible network (at least col. 5:10-29).

As per Claim 15.

arranging said electronic photographic images according to an event and said displaying said electronic photographic images occurs selectively according to said event (at least col. 8:7-26; col. 5:10-29).

As per Claims 16 and 19.

wherein said displaying is followed by the step of electing a quantitative and qualitative assertion for at least one of said electronic photographic images (at least col. 8:7-26; col. 5:10-29; col. 9:42-54).

As per Claim 17.

wherein said electing further comprises storing at least one of said electronic photographic images in an electronic proofbook (at least col. 5:10-29; online proof sheet).

As per Claim 18.

wherein said electronic proofbook is accessible only by said customer (at least col. 5:10-29; col. 8:8-20; online proof sheet).

As per Claim 20.

wherein said storing is preceded by the step of remotely altering/editing said electronic photographic images (at least col. 9:42-56; col. 8:8-37).

As per Claim 30.

further including the step of providing access to stored images for allowing image editing (at least col. 9:42-63; col. 7:25-42).

As per Claim 31.

wherein said editing step includes one or more of the steps of categorizing, sorting and titling (at least col. 9:42-56; col. 8:8-37).

As per Claim 35.

wherein said information comprises any one or more of the following:  
name of the event, name of the photographic subjects, the date the event is to take place; and the price list and/or packages to be used by host or guests when ordering merchandise associated with the event (at least col. 5:10-61; 8:49-58; eg. name/ price sheet).

As per Claim 36. The method of claim 32 wherein said access information is provided on a hard copy print provided to said customers (at least col. 8:8-37; index print).

### ***Response to Arguments***

4. Applicant's arguments filed 22 July 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., event profile specific details) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are



not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant additionally argues Garfinkle does not teach sequencing and captioning of the images for display. Applicant points to the Specification p. 10 lines 23-35 for sequencing and captioning details. Again, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Also in this instance, p. 10 lines 32-35 describes that "Once sequenced and captioned by the photographer, an online proofbook 308 corresponding to the event has been generated..". First, it is noted Applicant refers to the "Garfinkle et al. text (column 4, line 29) describing orientation of the digital image" (see Remarks p. 8). While this is, in fact, what Garfinkle describes in column 4, the rejection of the claims refers one to column 5, lines 10-29, as well as col. 9:42-56. In column 5, Garfinkle describes an online proof sheet (line 20) as well as the photographers production of, for example, an electronic slideshow (line 28). Garfinkle also describes the ability to view and edit rolls of film (the images and information associated with the roll) in column 9, lines 42-56.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Previously cited Jebens et al, Franklin et al, Yang et al, Yamade et al (scanned image sequencing), Anderson, Camrax, Epicad, Barraclough et al, Fredlund et al, and Khosla et al, Ogawa et al, Chai et al, Fredlund et al, Dellert et al, Sheridan, Shiota et al, Enomoto et al, Martin et al (payment server), Moghadam et al (networking photos), Brindle et al (photo description), Yien et al (networked image editing), Loeb (multimedia, photo delivery mechanisms), Woods (Kodak abstract for system claimed dated August '97), DaleLabs (digital film developing), Oldroyd Digital (digital film printing and editing), and WebPhotos (a very similar system to that claimed) are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY G. TODD whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/G. G. T./

Examiner, Art Unit 2457

/ARIO ETIENNE/

Supervisory Patent Examiner, Art Unit 2457